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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,613	01/15/2004	Ruupak Nanyamka Omar	0103281/0515640	6346

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EXAMINER	
LOWEN, ALYSSA	
ART UNIT	**PAPER NUMBER**
3711	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/758,613	OMAR, RUUPAK NANYAMKA	
	Examiner	Art Unit	
	Alyssa M. Lowen	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-43* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-43* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/18/06 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 22-27, 29 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash (6517406), Burton (D394479), Kimbrough (5926388) and Wolf (6655056). Cash discloses a sports novelty article having a three-dimensional representation of a baseball with a face (48) positioned on the ball such that the ball continues from the face to form the remainder of the head (Fig. 1). The relative size of the representation of the ball and the representation of the face is such that the ball is generally the size of the representation of the head (Fig. 1). The three-dimensional representation of the ball is proportional to the represented ball (Fig. 1). The novelty article is a figurine with arms and legs (14,16) wherein the combination of the three-

dimensional representation of the ball and the face is selectively attachable to the figurine (Fig. 2). Burton discloses a ball shaped doll having three-dimensional facial features and a ball that is generally the size of the represented head (Fig. 2).such that the representation of the face protrudes outwardly from the three-dimensional representation of the ball, showing this quality to be old in the ball figurine art. It would have been obvious to one of ordinary skill in the art to have the face of Cash display three-dimensional characteristics in order to have a doll with more interesting and visually appealing features. Cash and Burton disclose the basic inventive concept of a sports novelty article with the exception of the three-dimensional representation of a ball being computer generated. The claimed phrase "a computer-generated three-dimensional representation of a ball" is being treated as a product by process limitation; that is, that the representation of the ball is formed using computer generation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. Furthermore, Kimbrough teaches creating a novelty article by disposing a three-dimensional face of a known person, which can include a famous athlete (column 3 lines 12-13), onto a computer generated model of a three-dimensional object (Figs. 1 & 3) in order to form a doll or other novelty article (Figs. 3 & 4). The three-dimensional face has a continuous facial surface extending beyond the surface to which it is applied (Fig. 3). The continuous facial surface extends beyond an objects surface at a continuous perimeter,

which defines the boundary of the continuous facial surface relative to the objects surface (Fig. 3). The three-dimensional representation of the face is proportional to the represented face of the person (column 2 lines 15-20). The three-dimensional representation of the face is created using a three-dimensional digital model of the face obtained by scanning the face of the person (abstract). It would have been obvious to one of ordinary skill in the art to have the novelty article of Cash and Burton formed using computer generation techniques in order to create a doll or novelty article having the realistic features of an actual person (abstract). The two references do not expressly disclose the representation of the face being that of a famous athlete, however it is well known in the doll art to have the face of a doll resembling a famous person, athlete or celebrity, as such it would have been obvious to include this feature to increase the amusement value of the toy since it would be in a form that was well known and easily recognizable to a child. The two references disclose the basic inventive concept substantially as claimed with the exception of a stand. Wolf discloses a stand configured to be a three-dimensional representation of a venue such as a stadium associated with a sport such as baseball (Fig. 1) that is used to hold sports memorabilia such as a ball (column 4 lines 9-19) which would allow for the three-dimensional representation of the ball and the three-dimensional representation of the face to fit on the stand (Fig. 3). The stand is configured to hold only one ball shaped piece of memorabilia (Fig. 3). It would have been obvious to one of ordinary skill in the art from the teaching of Wolf to display the sports novelty article on a stand associated with the sport venue of the novelty article in order to be able to easily display a sports

collectible in an attractive and functional display since it is thematically related to the novelty article (abstract).

4. Claims 28 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough, Wolf and Lerner (3660926). The device of Cash, Burton, Kimbrough and Wolf discloses the basic inventive concept, substantially as claimed with the exception of the three-dimensional representation of the ball and face being partially hollow. Lerner however, discloses a toy figurine where the head portion is hollow for storing the elements of the figurine within (Fig. 2). It would have been obvious to one of ordinary skill in the art from the teaching of Lerner to have the head portion be hollow in order to allow for elements to be stored within.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Wolf. The references disclose the basic inventive concept, substantially as claimed with the exception of the figurine arms and legs having joints shaped like sports balls. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to give the figurine ball shaped joints because Applicant has not disclosed that the ball shaped joints provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well without ball shaped joints because a simpler yet still fun and interesting toy with arms and legs is created. Furthermore, it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon

to patentably distinguish the claimed invention from the prior art. *See in re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).*

6. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough, Wolf and further in view of Official Notice. The references disclose the basic inventive concept, substantially as claimed, with the exception of using voice signal technology. Official notice is taken that it is well known in the doll art to use voice signal technology, as such it would have been obvious to include this feature to create a more interesting and interactive toy.

7. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Wolf. The references disclose the basic inventive concept, with the exception of the face of the athlete being a caricature. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the face be a caricature because Applicant has not disclosed that a caricature provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the standard facial features because it would be more easily recognizable. Furthermore, it has been held that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *See in re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).*

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Wolf. The references disclose the basic inventive concept, with

the exception of the ball and face combination being fixedly secured to the stand. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have the ball and face combination fixedly secured to the stand because Applicant has not disclosed that the novelty article being fixedly secured to the stand provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the ball and face combination being removable from the stand because it would allow the child to play with the ball once removed. Furthermore, it has been held that the use of an integral construction instead of a separable structure would be a matter of obvious engineering choice. *See in re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).*

9. Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton and Kimbrough. Cash discloses a novelty toy doll having a face attached to a baseball (Fig. 1). Burton discloses a ball shaped doll having three-dimensional facial features and a ball that is generally the size of the represented head (Fig. 2) such that the representation of the face protrudes outwardly from the three-dimensional representation of the ball, showing this quality to be old in the ball figurine art. It would have been obvious to one of ordinary skill in the art to have the face of Cash display three-dimensional characteristics in order to have a doll with more interesting and visually appealing features. Cash and Burton disclose the basic inventive concept of a sports novelty article with the exception of the three-dimensional representation of an article of fame being computer generated. The claimed phrase "a computer-generated

three-dimensional representation of an article of fame" is being treated as a product by process limitation; that is, that the representation of the article of fame is formed using computer generation. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. Furthermore, Kimbrough discloses a novelty article having a three-dimensional representation of the face of a person which could include a famous person such as an athlete, wherein the three-dimensional representation of the face of the famous person is defined by a continuous facial surface, wherein the continuous facial surface comprises a three-dimensional representation of the eyes, nose and mouth of the person (Fig. 1). The three-dimensional representation of the face of the famous person is generally proportional to the face of the famous person (column 2 lines 15-20). A computer-generated three-dimensional representation of an article has a continuous article surface, wherein the three-dimensional representation of the article is generally proportional to the article (Fig. 3). The continuous facial surface is integral with the continuous article surface such that the three-dimensional representation of the article continues from the three-dimensional representation of the face of the famous person to form the remainder of the head of the famous person, wherein the continuous facial surface extends beyond the continuous article surface (Fig. 3). The three-dimensional face has a continuous facial surface extending beyond the surface to which it is applied (Fig. 3). The continuous facial surface extends beyond an objects surface at

a continuous perimeter, which defines the boundary of the continuous facial surface relative to the objects surface (Fig. 3). It would have been obvious to one of ordinary skill in the art to have the novelty article of Cash and Burton formed using computer generation techniques in order to create a doll or novelty article having the realistic features of an actual person (abstract).

10. Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cash, Burton, Kimbrough and Lerner. Cash discloses a novelty toy doll having a face attached to a baseball (Fig. 1). The three-dimensional representation of the head of the doll is proportionate to the three-dimensional representation of the body (Fig. 1). Burton discloses a ball shaped doll having three-dimensional facial features and a ball that is generally the size of the represented head (Fig. 2) such that the representation of the face protrudes outwardly from the three-dimensional representation of the ball, showing this quality to be old in the ball figurine art. It would have been obvious to one of ordinary skill in the art to have the face of Cash display three-dimensional characteristics in order to have a doll with more interesting and visually appealing features. Cash and Burton disclose the basic inventive concept of a sports novelty article with the exception of the three-dimensional representation of an article of fame being computer generated. The claimed phrases "a computer-generated three-dimensional representation of an article of fame" and "a computer-generated three-dimensional representation of the body of a famous person" are being treated as a product by process limitation; that is, that the representation of the article of fame and body are formed using computer generation. As set forth in MPEP 2113, product by

process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C 103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. Furthermore, Kimbrough discloses a novelty article having a computer-generated three-dimensional representation of the face of a person who can be famous defined by a continuous facial surface and a computer-generated three-dimensional representation of an article integral with the continuous facial surface (Fig. 3). The three-dimensional representation of the article continues from the three-dimensional representation of the face of the famous person to form the remainder of the head of the famous person (Fig. 3). The combination of the three-dimensional representation of the face of the famous person and the three-dimensional representation of the article has a hollow portion (Fig. 3). It would have been obvious to one of ordinary skill in the art to have the novelty article of Cash and Burton formed using computer generation techniques in order to create a doll or novelty article having the realistic features of an actual person (abstract). Lerner discloses a toy having a three-dimensional representation of the body of a person that is configured to fit within a hollow portion of a head (Fig. 2). The three-dimensional representation of the body is disproportionate to the three-dimensional representation of the face (Fig. 1). It would have been obvious to one of ordinary skill in the art from the teaching of Lerner to have the head portion be hollow in order to allow for elements to be stored within so they will not become lost when not in use.

Response to Arguments

11. Applicant's arguments with respect to claims 22-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Lowen whose telephone number is 571-272-2684. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AML

EUGENE KIM
SUPERVISORY PATENT EXAMINER